

RESTRICTION

Claims 11-30 are subject to a restriction requirement under 35 U.S.C. § 121. The Action identifies a restriction to two groups of inventions. Applicants hereby elect Group I, claims 10-23 and 27-30 with traverse, for continued prosecution. Please cancel claims 24-26.

ELECTION

Applicants provisionally elect with traverse nucleic acid/amino acid sequence SEQ ID NO:54 for prosecution on the merits. Applicants respectfully believe that claims 10-23 and 27-30 read on the elected nucleic acid/amino acid sequence.

TRAVERSE

Every requirement to restrict has two aspects, (1) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct, and (2) the reasons for insisting upon restriction therebetween. MPEP § 808. [Emphasis in the original]. With regard to the first aspect, The Examiner failed to provide a reason as to why the species identified in the Official Action are distinct.

With regard to the second aspect, the reasons under MPEP § 808 given by the Examiner for insisting upon exercising his authority under 35 U.S.C. § 121 to require restriction must be reasons approved by the Commissioner. The reasons approved by the Commissioner are set out in MPEP § 803: (1) the inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i); and (2) there must be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 806.04(a)-(j), § 808.01(a) and 808.02). Examiner must provide reasons and/or examples to support conclusions. MPEP § 803.

For purposes of the initial requirement, a serious burden on the examiner may be shown, *prima facie*, if the examiner shows by appropriate explanation either separate

classification, separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant. MPEP § 803. Applicants respectfully assert that the Examiner has failed to make a *prima facie* case that restriction is required. The Official Action to which this reply is responsive provides no reason as to why the nucleic acid/amino acid sequences of the invention as claimed are either independent or distinct. The Action merely provides a conclusion that such is the case. Further, the Examiner provides no reason for insisting upon restriction between the nucleic acid/amino acid sequences of the invention. Therefore, Applicants respectfully assert that the *prima facie* requirements of MPEP § 803 have not been met.

Further, the Action failed to establish that a serious burden would be imposed on the Examiner if restriction were not required. In particular, the Examiner failed to explain whether there is a separate classification of the separate nucleic acid/amino acid sequences. The Examiner failed to establish that separate fields of searching would be required. That is, the Examiner failed to establish that, even if the distinct nucleic acid/amino acid sequences may be classified in the same class or subclass, a complete search would require examination of other classes and subclasses that differ for each distinct nucleic acid/amino acid sequence, thereby imposing a burden on the Examiner if all the inventions were examined in the same application. Finally, the Examiner failed to establish that the distinct nucleic acid/amino acid sequences have achieved a separate status in the art, even though they are classified together. MPEP § 802. These are the only explanations approved by the Commissioner to show that a serious burden would be imposed on the Examiner in absence of the restriction requirement.

An example included in the disclosure of the Application that the nucleic acid/amino acids sequences may be classified in the same class or subclass may be found on page 11, lines 11-21 as follows:

As used herein, the term "F-box proteins" refers to the amino acid sequence of substantially purified proteins involved in proteolysis, including but not limited to proteins involved in the ubiquitin-ligase complex obtained from any species, including bovine, ovine, porcine,

murine, equine, and human, from any source whether natural, synthetic, semi-synthetic, or recombinant. The F-box is a sequence of 35-45 amino acids and allows the F-box proteins to enter into complexes with Skp1. Thus, the F-box proteins bind Skp1, and contain a motif that displays sequence similarity to Grr1 and Cdc4. This conserved structural motif is included in the sequence alignments shown in Figure 7 (i.e., the amino acid residues that are shared by the F-box proteins shown). However, it is not intended that the term be limited to the exact sequences as set forth in Figure 7.

Because the Examiner did not provide any reason for requiring restriction, Applicants respectfully urge that the requirement for restriction/election is improper. Applicants respectfully request reconsideration and withdrawal of the restriction/election requirement.

CONCLUSION

Applicants provisionally elect Group I, claims 10-23 and 27-30 with traverse, and request a cancellation of claims 24-26. In addition, Applicants provisionally elect nucleic acid/amino acid sequence SEQ ID NO:54. For the reasons set forth above, Applicant respectfully requests reconsideration by the Examiner and withdrawal of the restriction/election requirement. Applicants submit that claims 10-23 and 27-30 are fully patentable. Favorable consideration and allowance of the Application is therefore respectfully requested. If the Examiner has any questions or comments, or if further clarification is required, it is requested that the Examiner contact the undersigned at the telephone number listed below.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. §1.136(a) for a period of time sufficient to enable this document to be timely filed. Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Deposit Account No. 07-0153. Any refund should be credited to the same account.

Dated: October 25, 2002.

Respectfully submitted,

GARDERE WYNNE SEWELL LLP

A handwritten signature in black ink, appearing to read 'T. C. Wright', is written over a horizontal line.

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